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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,622	12/21/2001	Daniela Giacchetti	05725.0975-00	3918
22852	7590	10/09/2007	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			BORISSOV, IGOR N	
ART UNIT		PAPER NUMBER		
3628				
MAIL DATE		DELIVERY MODE		
10/09/2007		PAPER		

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**MAILED**  
*OCT 09 2007*  
**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/024,622  
Filing Date: December 21, 2001  
Appellant(s): GIACCHETTI ET AL.

Anthony M. Gutowski  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 03/20/2007 appealing from the Office action  
mailed 10/04/2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US 2002/0054714 A1	Hawkins et al.	May 9, 2002
WO 01/87245 A2	Marapane et al.	Nov. 22, 2001
WO 01/18674 A2	Maloney et al.	Mar. 15, 2001

AS/400 Redbook Softcopy Library, an image of a CD (Document).

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections under 35 USC § 112 have been withdrawn.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-25 and 27-61 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a "useful, concrete and tangible result" is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "useful, concrete and tangible result". The test for practical application as applied by the examiner involves the determination of the following factors"

**(a) "Useful"** – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

**(b) “Tangible”** – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

**(c) “Concrete”** – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

Claim 1 recites:

1. A method, comprising:

obtaining first information representative of an external body condition of a subject;

obtaining second information representative of the external body condition of the subject after the subject uses a beauty product;

facilitating storage of information reflecting the subject's usage of the beauty product; and

enabling the subject to view the first information, the second information, and at least part of the stored information.

Specification provides the following definitions of terms “enabling” and “facilitating” (page 32, paragraph [089]):

"enabling", "facilitating", and "causing" an action refer to one or more of a direct act of performing the action, and any indirect act of encouraging or being an accessory to the action. Thus, the terms include partnering or cooperating with an entity who performs the action and/or referring commerce to or having commerce referred from an entity who performs the action. Other examples of indirect activity encompassed within the definitions of "enabling" "facilitating" and "causing" may include providing a subject with one or more of tools to knowingly aid in performing the action, providing instructions on how to perform the action, providing prompts or cues to perform the action, or expressly encouraging performance of the action. Indirect activity may also include cooperating with an entity who either directly performs the action or who helps another perform the action. Tools may include software, hardware, or access (either directly, through hyperlink, or some other type of cooperation or partnering) to a network location (e.g., web site) providing tools to aid in performing the action. Thus, phrases such as "enabling access" and "enabling display" do not necessarily require that the actor actually access or display anything."

Accordingly, based on specification definition, the examiner understand the method of claim 1 as:

taking a few notes (possibly by using a pencil and a piece of paper) representative of an external body condition of a subject;

taking another few notes (possibly by using a pencil and a piece of paper) representative of the external body condition of the subject after the subject uses a beauty product;

expressly encouraging the subject not to lose (facilitating storage) said taken notes reflecting the subject's usage of the beauty product; and

expressly encouraging (enabling) the subject to look at first notes, the second notes, and at least part of the stored information.

35 U.S.C. § 101 provides:

Whoever invents or discovers any new and useful **process, machine, manufacture, or composition of matter**, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Traditional process can be understood as either transforming subject matter or implemented by one of the other three categories. See *Tilghman v. Proctor*, 102 U.S. 707, 722 (1880) ("where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations are called processes."); see also *AT&T*, 172 F.3d at 1356, 50 USPQ2d at 1450 ("any step-by-step process, be it electronic, chemical, or mechanical, involves an 'algorithm' in the broad sense of the term.").

Method claim 1 does not recite any electrical, chemical, or mechanical acts or results, typical in traditional process claims; the claim does not require any machine or apparatus to perform the recited steps; and, finally, the claim does not provide any physical transformation of an article to a different state or thing, nor does it require any transformation of data or signals. However, "...a process claim [in] compliance with Section 101 requires some kind of transformation or reduction of subject matter." See *In re Schrader*, 22 F.3d 295, 30 USPQ2d at 1459.

Furthermore, the claim does not provide any indication who or what is performing the steps of: "obtaining information", "facilitating storage of information", and "enabling the subject to view the information". Accordingly, the claim is so broad that it is directed to the abstract idea itself, rather than its practical implementation.

So as the claim 1 is directed to the abstract idea itself, does not require any machine or apparatus to perform the recited steps, and does not require implementing a mathematical formula or algorithm to transform data, the information recited in the claim does not represent a real world activity such as found in *Arrhythmia*, *Alappat*, or *State Street*. As such, claim 1 falls outside the scope of § 101 as failing to apply its abstract idea to produce a useful and concrete and tangible result.

Claim 5 recites:

5. A method, comprising:

providing information about beauty products;

facilitating electronic capture of a first image of an external body condition of a subject;

encouraging the subject to use at least one of the beauty products;

facilitating, after the subject has used the at least one beauty product, electronic capture of a second image of the external body condition of the subject, wherein capture of at least one of the first and second images occurs at a beauty facility;

facilitating capture and storage of information reflecting usage of at least one of the beauty products by the subject, the usage occurring on at least one occasion between capture of the first image and capture of the second image; and

enabling the subject to view the first image, the second image, and the stored information on a display device, to thereby visually observe changes that occurred between times when the first and second images were captured.

While capturing images and observing said captured images may be deemed useful, the examiner maintains that claim 5, as well as claim 1, does not fall into a "process" category for the § 101 analysis. A typical process may be defined as: "...where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations are called processes." See *Tilghman v. Proctor*, 102 U.S. 707, 722 (1880). See also *AT&T*, 172 F.3d at 1356, 50 USPQ2d at 1450 ("any step-by-step process, be it electronic, chemical, or mechanical, involves an 'algorithm' in the broad sense of the term.").

While claim 5 recites "electronic capture of a first and second images of an external body condition of a subject", the claim does not require any transformation of said captured data, nor does it require physical transformation of an article to a different state or thing. However, "...a process claim [in] compliance with Section 101 requires

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some kind of transformation or reduction of subject matter." See *In re Schrader*, 22 F.3d 295, 30 USPQ2d at 1459.

Accordingly, without requiring any machine or apparatus to perform the recited steps, or implementing a mathematical formula or algorithm to transform data, claim 5 does not represent a real world activity such as found in *Arrhythmia*, *Alappat*, or *State Street*. As such, claim 5 is rejected as being directed to non-statutory subject matter.

Same reasoning applied to claims 31 and 39, 45, 48, 50. The steps of: "storing information" or "providing instructions for storage of the information" does not require any transformation of data, nor does it require physical transformation of an article to a different state or thing.

As per Claim 32, the step of: "providing a beauty facility with technology for capturing external body condition images of a customer" could be understood as merely providing a beauty consultant with a digital camera; and the step of: "instructing the beauty facility to capture images of the external body condition before and after application of the at least one cosmetic product;" could be understood as explaining the beauty consultant how to use the digital camera. Accordingly, method claim 32 does not require any transformation of data, nor does it require physical transformation of an article to a different state or thing.

As per Claim 44, 46, and 49, the steps of: "enabling the subject to compare"; "determining whether the subject's cosmetic usage is consistent with... ", and "analyzing the first and second information" could be understood as encouraging a subject to make a certain decision.

The remaining dependent claims do not cure § 101 deficiencies. Accordingly, Claims 1-25 and 27-61 are rejected as being directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 31-38, 49, 57, 60 and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Hawkins et al. (US 2002/0054714).**

Hawkins teaches a method for evaluating cosmetic product on a consumer, comprising:

***Independent Claim***

**Claim 31.** Selecting (prescribing) a cosmetic product for trial on the consumer's body [0038]; capturing an image of a body feature (*establishing a subject record; (Examiner points out that ability to compare the captured image/record of a consumer with a second image captured later indicated comparing the second image with the image of record or first image. Without establishing a record/first image the "comparing" step would not be possible)* [0039]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer (*associating the at least one second image with the subject record*) [0041], wherein said capturing occurs at a sales counter (*beauty facility*) [0053]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (*associating the at least one second image with the subject record (Examiner points out that without a step of associating the second image with the subject record it would not be possible to conduct the "comparing" step, because nobody would know with which (second) image the first image has to be compared)*); wherein the use of a computer inherently indicates

*storing of the transformed information) [0044]; displaying captured and transformed images to the user [0044].*

**Claim 32.** Selecting a cosmetic product and capturing an image of a body feature before and after application of the cosmetic product at a sales counter (beauty facility) [0039]; [0053]; and displaying captured and transformed images to the user [0044]. Selecting the cosmetic product at the sales counter (*beauty facility*) inherently indicates *distributing* said cosmetic product to the point of sale. Examiner points out that without distributing said cosmetic product from the place of manufacturing of said product to said sales counter prior to offering said cosmetic product to the subject, there would not be any product to select from by the subject and apply to the subject at said sales counter. Therefore, the step of "*distributing* said cosmetic product to the point of sale", in its broadest sense, is inherently disclosed in Hawkins. Furthermore, Hawkins teaches that the subject is assisted with said method at said sales counter by an operator [0053]. Examiner stipulates that the professional assistance indicates a provision of the necessary skill and knowledge about beauty product and how to apply said beauty product including safe application technique, considering a type of skin of an individual, time of a day and time of a year (season), allergy consideration and compatibility with other cosmetic or medical product the subject may use, without mentioning the knowledge of current trend in beauty fashion. Said necessary skill and knowledge is not the type of skill an average person would have, but one that would require studying and specific training. For example, the wrong advice may trigger a serious allergy reaction or an accidental injury, causing complicated health and legal consequences. Therefore, without receiving special *instructions or training* by said operator (facility) how to conduct said method prior to said "assisting" the subject, said operator would not be able to provide said services at the professional level and to conduct said method steps. Therefore, the "instructing" step is inherently disclosed in Hawkins.

**Claim 49.** Selecting a cosmetic product for trial on the consumer's body (providing information) [0038]; capturing an image of a body feature [0039]; capturing a

further image of the body feature at a later time [0041]; digitally transforming the captured images to determine differences that occurred in a body condition [0044]; offering (prescribing) a cosmetic product based on the results [0053]. As per “providing instructions” per se, reasoning applied to claim 32 is equally applicable to claim 49.

**Dependent Claims**

**Claim 33.** Capturing images at the beauty facility [0053] inherently indicates providing “know-how” for said capturing to the beauty facility (reasoning applied to claim 32 is equally applicable to claim 33).

**Claims 34-36.** Providing a kit for displaying a consumer’s skin images, including a camera and a programmable device [0026], inherently indicates providing necessary software (drivers) for the system to operate.

**Claim 37.** Same reasoning as applied to **claim 34**.

**Claim 38.** A cosmetic product is selected for a trial for a consumer before each image is recorded [0013]; [0014].

**Claim 57.** Same reasoning as applied to claim 49.

**Claim 60.** Same reasoning as applied to claim 49.

**Claim 61.** Same reasoning as applied to claim 49.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1-24, 27-30, 48 and 50-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (US 2002/0054714) in view of Marapane et al. (WO 01/87245).**

Hawkins teaches a method and system for evaluating cosmetic product on a consumer, comprising:

**Independent Claims**

**Claim 1.** Capturing an image of a body feature (obtaining first information) [0039]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer (obtaining first information) [0041]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product and displaying captured and transformed images to the user [0044].

Hawkins does not explicitly teach storing information reflecting the *subject's usage of the beauty product*.

Marapane et al. (Marapane) teaches a method and system for recommending beauty products (hair color agents), said method including obtaining (facilitating storage) information regarding how often a subject has colored his/her hair over the past year (Figs. 1 and 16, item 130; page 4, lines 16-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include facilitating storage of information reflecting the subject's usage of the beauty product, as disclosed in Marapane, and, accordingly, displaying stored information to the subject, because it would advantageously allow to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

**Claim 5.** Hawkins teaches: providing information about beauty products (selecting a cosmetic product for trial on the consumer's body) [0038]; capturing an image of a body feature [0039]; encouraging the subject to use at least one beauty

product [0053]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer [0041], wherein said capturing occurs at a sales counter (*beauty facility*) [0053]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (using a computer inherently indicates *storing of the transformed information*) [0044]; displaying captured and transformed images to the subject [0044].

Hawkins does not explicitly teach storing information reflecting the subject's usage of the beauty product, the usage occurring on at least one occasion between capture of the first image and capture of the second image.

Marapane et al. (Marapane) teaches a method and system for recommending beauty products (hair color agents), said method including taking initial color reading of the subject' hair; applying a beauty product to the subject's hair (coloring step); taking a second color reading of the subject' hear after said coloring step (page 8, lines 8-10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include storing information reflecting the subject's usage of the beauty product, wherein the usage occurring on at least one occasion between capture of the first image and capture of the second image as disclosed in Marapane, and, accordingly, displaying captured information to the subject, because it would advantageously allow to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

**Claim 48.** Hawkins teaches: offering for sale beauty products (selecting a cosmetic product for trial on the consumer's body [0038]; furthermore the "sales representative" in [0035] and "the point of purchase" in [0053] indicates the "sale" feature); capturing an image of a body feature [0039]; encouraging the subject to use at least one beauty product [0053]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer [0041], wherein said capturing occurs at a sales counter (*beauty facility*) [0053]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (using a

computer inherently indicates *storing of the transformed information*) [0044]; displaying captured and transformed images to the subject [0044].

Hawkins does not explicitly teach storing information reflecting the subject's usage of the beauty product, the usage occurring on at least one occasion between capture of the first image and capture of the second image.

Marapane et al. (Marapane) teaches a method and system for recommending beauty products (hair color agents), said method including taking initial color reading of the subject' hair; applying a beauty product to the subject's hair (coloring step); taking a second color reading of the subject' hear after said coloring step (page 8, lines 8-10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include storing information reflecting the subject's usage of the beauty product, wherein the usage occurring on at least one occasion between capture of the first image and capture of the second image as disclosed in Marapane, and, accordingly, displaying captured information to the subject, because it would advantageously allow to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

**Claim 50.** Selecting a cosmetic product for trial on the consumer's body (providing information about beauty care) [0038]; capturing an image of a body feature in a first time frame [0039]; capturing a further image of the body feature at a later time (second time frame) [0041]; digitally transforming the captured images to determine differences that occurred in a body condition [0044]; offering a cosmetic product based on the results [0053], wherein capturing an image of a body feature [0039] indicates a step of *establishing a subject record*. It is noted that ability to compare the first captured image/record of a consumer with a second image captured later indicates comparing the second image with the image of record, or first image. Without establishing such a record, or the first image, the "comparing" step simply would not be possible; at the beauty facility, serving a plurality of customers, how would a sales representative/operator know which images, including a first one and a second, out of a plurality of

images of a plurality of consumers, have to be compared if there is no established record about said consumer? And how would it be possible to display both images to the subject if both first and second images/information are not in the subject record? Furthremore, Hawkins' teaching that at least one "capturing" step can be conducted at the subject's home by himself over the Internet [0053] indicates enabling subject to maintain control of the subject record. As per "providing instructions" per se, reasoning applied to claim 32 is equally applicable to claim 50.

Hawkins does not explicitly teach storing information reflecting subject's behavior between capture of the first image and capture of the second image.

Marapane et al. (Marapane) teaches a method and system for recommending beauty products (hair color agents), said method including taking initial color reading of the subject' hair; applying a beauty product to the subject's hair (behavior step); taking a second color reading of the subject' hear after said coloring step (page 8, lines 8-10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include providing instructions for storing information reflecting subject's behavior between capture of the first image and capture of the second image, as disclosed in Marapane, and, accordingly, displaying captured information to the subject, because it would advantageously allow to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

**Dependent Claims.**

**Claims 2-3.** Same reasoning as applied to **claim 1.**

**Claim 4.** Said method and system, wherein obtaining information is occurs over the Internet [0053].

**Claims 6-9.** Said method and system, wherein a cosmetic product is offered at the point-of-sale [0053].

**Claim 10.** Said method and system, wherein enabling electronic capturing of at least one of the first and second first images includes providing the beauty facility with an image capture device [0053].

**Claim 11.** Said method and system, wherein access to the image capture device is provided over the Internet [0053].

**Claim 12.** Said method and system, wherein the external body condition is a skin condition of the subject's face [0046].

**Claims 13-14.** Same reasoning as applied to **claim 32**.

**Claim 15.** Same reasoning as applied to **claim 5**.

**Claim 16.** Same reasoning as applied to **claim 5**.

**Claim 17.** Same reasoning as applied to **claim 5**.

**Claim 18.** Displaying original and transformed images side-by-side to the consumer so that the consumer forced to pick one image [0044].

**Claims 19-20.** Providing a kit for displaying a consumer's skin images, said kit including a camera and a programmable device [0026], thereby inherently indicating providing necessary software (*drivers*) for the system to operate.

**Claims 21-22.** Same reasoning as applied to **claim 5**.

**Claim 23.** Said method, wherein said cosmetic product is offered by a manufacturer [0053].

Also, said method, wherein said cosmetic product is offered to the consumer at a retail terminal [0053]. Information as to *is the retailer a manufacturer, reseller or wholesaler* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembicza* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

The recited method steps would be performed the same regardless whether the distributor is a manufacturer, reseller or wholesaler.

**Claim 24.** Displaying a consumer's skin images on a computer monitor [0026] indicates use of a *tangible recording media*.

**Claim 27.** Communications via the Internet indicates viewing said images at locations remote from the beauty facility [0053].

**Claim 28.** Hawkins teaches that capturing of the consumer's first and second images may be provided either in the beauty facility, or user's home (*location remote from the beauty facility*), and that the communication between the beauty facility and the consumer may be conducted over the Internet [0053].

Hawkins and Marapane does not specifically teach that after the *first* image is taken in the beauty facility, the consumer *is recommended* to capture the *second* image at the *location remote from the beauty facility*.

However, Hawkins does teach that said method can be conducted from consumer' home using a digital camera and the Internet [0053].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include *recommending* the consumer to take the second image at home, because it would be convenient for the consumer to take the second image at the time suitable for the consumer.

**Claim 29.** Same reasoning as applied to **claim 5**.

**Claim 30.** Same reasoning as applied to **claim 27**.

**Claim 51.** Hawkins teaches that the consumer is enabled to maintain control through the use of software that stores the record at a location with access controlled by the consumer (conducting said method using consumer's digital camera at home and over the Internet) [0053].

**Claim 52.** Hawkins teaches said method and system, wherein the location is a portable information storage medium (the use of a computer at consumer's home indicates the use of the portable information storage medium) [0053].

**Claim 53.** Hawkins teaches displaying to the subject a digitally transformed image of the subject's face to demonstrate effects (effectiveness) of a cosmetic product treatment [0044].

**Claims 54-56.** Same reasoning as applied to Claim 5 (Hawkins; [0044]).

**Claims 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney et al. (WO 01/18674 A2) in view of Marapane et al. (WO 01/87245).**

**Independent Claims**

**Claim 45.** Maloney et al. (hereinafter Maloney) teaches a method for providing a customized product combination to a consumer, comprising: providing by the consumer information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement and lifestyle (page 7, lines 1-2); obtaining feedback from the consumer (*update*) for the cosmetic products offered (page 12, lines 15-16); based on the collected and updated information recommending a cosmetic product to the consumer (page 12, lines 15-16).

Maloney does not explicitly teach that said provided by the consumer information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement includes customer cosmetic product usage.

Marapane teaches a method and system for recommending beauty products (hair color agents), said method including obtaining information regarding how often a subject has colored his/her hair over the past year (Figs. 1 and 16, item 130; page 4, lines 16-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include storing information reflecting the subject's usage of the beauty product, as disclosed in Marapane, and, accordingly, displaying captured information to the subject, because it would advantageously allow to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

**Claim 46.**

Maloney teaches said method for providing a customized *cosmetic* product combination to a consumer, comprising: providing (recording) by the subject information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement and lifestyle over the Internet (page 7, lines 1-2; page 15, line 29 – page 16, line 4); comparing the recorded information with a database of the same type of information of a plurality of individuals (page 7, lines 1-2, 9-11); determining whether the information provided by the subject is consistent with the same type of information of a plurality of individuals (page 7, lines 3-11; page 9, lines 21-22); recommending a cosmetic product to the subject based on said determination (page 7, lines 13-14). Furthermore, Maloney teaches while the consumer is initially assigned to an appropriate category of consumers (consistent with the cosmetic usage and lifestyles of a trend of use of at least some of the plurality of individuals), the classifying neural network can continuously update its decision by incorporating consumer feedback to provide a customized beauty product to the consumer (page 9, lines 12-32; page 10, lines 8-14), thereby suggesting providing the customized product when subject's cosmetic usage is inconsistent with the cosmetic usage and lifestyles of a trend of use of at least some of the plurality of individuals.

Maloney does not explicitly teach that said provided by the consumer information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement includes customer cosmetic product usage.

Marapane teaches a method and system for recommending beauty products (hair color agents), said method including obtaining information regarding how often a subject has colored his/her hair over the past year (Figs. 1 and 16, item 130; page 4, lines 16-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include storing information reflecting the subject's usage of the beauty product, as disclosed in Marapane, and, accordingly, displaying captured information to the subject, because it would advantageously allow

to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

*Dependent Claim.*

**Claim 47.** Enabling the subject to record personal information about the subject's physical characteristics, and wherein the caused at least one product recommendation is a function of the subject's lifestyle and physical information (Maloney; lines 1-2).

**Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of Marapane et al. and further in view of AS/400 Redbook Softcopy Library, an image of a CD (Document).**

*Dependent Claim*

**Claim 25.** Hawkins teaches: displaying a consumer's skin images on a computer monitor [0026], thereby inherently indicating use of a *tangible recording media*.

However, Hawkins and Marapane does not teach that said tangible recording media includes a *visible marking* identifying a distributor.

Document discloses an image of a CD (which appears to be released in June, 1995), containing a *visual depiction* of a manufacturer/distributor (IBM).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins and Marapane to include that said tangible recording media includes a *visible marking* identifying a distributor, because it would advantageously promote distributor's products.

**Claims 39-44 and 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney.**

*Independent Claims*

**Claim 39.** Maloney teaches: providing a subject with a image capturing device for recording and displaying personal beauty information including an image of a subject (page 20, lines 27-28; page 26, claim 20); wherein said recording and displaying indicates recording said information on a computer-readable media. Furthermore, Maloney teaches that said recorded information could be read at beauty facilities (a central location or kiosks) and updated (page 11, line 17-18; page 15, lines 4-6). Providing the subject with image capturing device at home indicates updating said personal beauty information at a location remote from the beauty facility.

Maloney does not explicitly teach that said computer-readable media is a transportable computer-readable media.

However, it is old and well known that computer-readable media can be a transportable. For example, Maloney teaches floppy diskettes, compact discs and laser discs as a computer-readable medium (page 13, lines 31-32).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said personal beauty information is recorded on a *transportable* media, because it would advantageously allow to use this method in geographical locations where network communication is not available.

**Claim 44.** Maloney teaches: recording, at beauty facilities (a central location or kiosks), personal beauty information of a subject, including an image of the subject (page 11, line 17-18; page 26, claim 20); wherein said recording and displaying obviously indicates recording said information on a computer-readable media. Furthermore, Maloney teaches that said recorded information can be accessed by the subject from home (remotely from the beauty facilities) (page 11, lines 13-14; page 6, lines 30-33); wherein providing the subject with image capturing device at home obviously indicates updating said personal beauty information at a location remote from the beauty facility. Furthermore, Maloney teaches allowing the subject to compare original and updated personal beauty information (page 20, lines 27-34).

Maloney does not explicitly teach that said computer-readable media is a transportable computer-readable media.

However, it is old and well known that computer-readable media can be a transportable. For example, Maloney teaches floppy diskettes, compact discs and laser discs as a computer-readable medium (page 13, lines 31-32).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said personal beauty information is recorded on a *transportable* media, because it would advantageously allow to use this method in geographical locations where network communication is not available.

**Dependent Claims**

**Claim 40.** Providing the subject with image capturing device at home indicates updating step at a remote location (See reasoning applied to **claim 39**).

**Claims 41-43.** See reasoning applied to **claim 39**.

**Claim 58.** Maloney teaches: providing by the consumer personal beauty information (page 7, lines 1-2); wherein said information is provided on a transportable medium (a floppy diskette or compact disc, a handwritten questionnaire (page 13, line 31; page 6, line 32) or a digital camera (page 26, claim 20).

**Claim 59.** Maloney teaches: enabling a beauty facility (a central location or a kiosk) to record on transportable medium personal beauty information relating to beauty habits (page 6, line 32; page 7, lines 1-2; page 11, line 17; page 15, line 5; page 17, line 33).

**(10) Response to Argument**

**(10.1) Arguments A and B (Brief, pages 14-15)**

Claim Rejections under 35 USC § 112 have been withdrawn, therefore Applicant's arguments with respect to Claim Rejections under 35 USC § 112 are moot.

(10.2) **Argument C. (Brief, pages 15-17)**

Applicant argues that the rejection of claims 1-25 and 27-61 Under 35 U.S.C. § 101 should be reversed, because claims 1-25 and 27-61 provide useful and tangible results.

In response to applicant's argument the examiner points out that an invention, which is eligible for patenting under 35 U.S.C. 101, is in the "useful arts" when it is a *machine, manufacture, process or composition of matter*, which produces a concrete, tangible, and useful result (see the discussion above). In this case, method **claim 1** recites:

1. *A method, comprising:*

*obtaining first information representative of an external body condition of a subject;*

*obtaining second information representative of the external body condition of the subject after the subject uses a beauty product;*

*facilitating storage of information reflecting the subject's usage of the beauty product; and*

*enabling the subject to view the first information, the second information, and at least part of the stored information.*

Specification provides the following definitions of terms "enabling" and "facilitating" (page 32, paragraph [089]):

"enabling", "facilitating", and "causing" an action refer to one or more of a direct act of performing the action, and any indirect act of encouraging or being an accessory to the action. Thus, the terms include partnering or cooperating with an entity who performs the action and/or referring commerce to or having commerce referred from an entity who performs the action. Other examples of indirect activity encompassed within the definitions of "enabling" "facilitating" and "causing" may include providing a subject with one or more of tools to knowingly aid in performing the action, providing instructions on how to perform the action, providing prompts or cues to perform the action, or expressly encouraging performance of the action. Indirect activity may also include cooperating with an entity who either directly performs the action or who helps another perform the action. Tools may include software, hardware, or access (either directly, through hyperlink, or some other type of cooperation or partnering) to a network location (e.g., web site) providing tools to aid in performing the action. Thus, phrases such as "enabling access" and "enabling display" do not necessarily require that the actor actually access or display anything."

Accordingly, based on specification definition, the examiner understand the method of **claim 1** as:

taking a few notes (possibly by using a pencil and a piece of paper) representative of an external body condition of a subject;

taking another few notes (possibly by using a pencil and a piece of paper) representative of the external body condition of the subject after the subject uses a beauty product;

expressly encouraging the subject not to lose (facilitating storage) said taken notes reflecting the subject's usage of the beauty product; and

expressly encouraging (enabling) the subject to look at first notes, the second notes, and at least part of the stored information.

35 U.S.C. § 101 provides:

- Whoever invents or discovers any new and useful *process, machine, manufacture, or composition of matter*, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Traditional process can be understood as either transforming subject matter or implemented by one of the other three categories. See *Tilghman v. Proctor*, 102 U.S.

707, 722 (1880) ("where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations are called processes."); see also *AT&T*, 172 F.3d at 1356, 50 USPQ2d at 1450 ("any step-by-step process, be it electronic, chemical, or mechanical, involves an 'algorithm' in the broad sense of the term.").

Method **claim 1** does not recite any electrical, chemical, or mechanical acts or results, typical in traditional process claims; the claim does not require any machine or apparatus to perform the recited steps; and, finally, the claim does not provide any physical transformation of an article to a different state or thing, nor does it require any transformation of data or signals. However, "...a process claim [in] compliance with Section 101 requires some kind of transformation or reduction of subject matter." See *In re Schrader*, 22 F.3d 295, 30 USPQ2d at 1459.

Furthermore, the claim does not provide any indication who or what is performing the steps of: "obtaining information", "facilitating storage of information", and "enabling the subject to view the information". Accordingly, the claim is so broad that it is directed to the abstract idea itself, rather than its practical implementation.

So as the **claim 1** is directed to the abstract idea itself, does not require any machine or apparatus to perform the recited steps, and does not require implementing a mathematical formula or algorithm to transform data, the information recited in the claim does not represent a real world activity such as found in *Arrhythmia*, *Alappat*, or *State Street*. As such, claim 1 falls outside the scope of § 101 as failing to apply its abstract idea to produce a useful and concrete and tangible result.

**Claim 5** recites:

5. A method, comprising:  
providing information about beauty products;

facilitating electronic capture of a first image of an external body condition of a subject;

encouraging the subject to use at least one of the beauty products;

facilitating, after the subject has used the at least one beauty product, electronic capture of a second image of the external body condition of the subject, wherein capture of at least one of the first and second images occurs at a beauty facility;

facilitating capture and storage of information reflecting usage of at least one of the beauty products by the subject, the usage occurring on at least one occasion between capture of the first image and capture of the second image; and

enabling the subject to view the first image, the second image, and the stored information on a display device, to thereby visually observe changes that occurred between times when the first and second images were captured.

While capturing images and observing said captured images may be deemed useful, the examiner maintains that **claim 5**, as well as **claim 1**, does not fall into a "process" category for the § 101 analysis. A typical process may be defined as: "...where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations are called processes." See *Tilghman v. Proctor*, 102 U.S. 707, 722 (1880). See also *AT&T*, 172 F.3d at 1356, 50 USPQ2d at 1450 ("any step-by-step process, be it electronic, chemical, or mechanical, involves an 'algorithm' in the broad sense of the term.").

While **claim 5** recites "electronic capture of a first and second images of an external body condition of a subject", the claim does not require any transformation of said captured data, nor does it require physical transformation of an article to a different state or thing. However, "...a process claim [in] compliance with Section 101 requires some kind of transformation or reduction of subject matter." See *In re Schrader*, 22 F.3d 295, 30 USPQ2d at 1459.

Accordingly, without requiring any machine or apparatus to perform the recited steps, or implementing a mathematical formula or algorithm to transform data, **claim 5** does not represent a real world activity such as found in *Arrhythmia*, *Alappat*, or *State Street*, and thus is rejected as being directed to non-statutory subject matter.

Same reasoning applied to claims 31 and 39, 45, 48, 50. The steps of: “*storing information*” or “*providing instructions for storage of the information*” does not require any transformation of data, nor does it require physical transformation of an article to a different state or thing.

As per **Claim 32**, the step of: “*providing a beauty facility with technology for capturing external body condition images of a customer*” could be understood as merely providing a beauty consultant with a digital camera; and the step of: “*instructing the beauty facility to capture images of the external body condition before and after application of the at least one cosmetic product*;” could be understood as explaining the beauty consultant how to use the digital camera. Accordingly, method **claim 32** does not require any transformation of data, nor does it require physical transformation of an article to a different state or thing.

As per **Claim 44, 46, and 49**, the steps of: “*enabling the subject to compare*”; “*determining whether the subject's cosmetic usage is consistent with...*”, and “*analyzing the first and second information*” could be understood as encouraging a subject to make a certain decision.

The remaining dependent claims do not cure § 101 deficiencies. Accordingly, **Claims 1-25 and 27-61** fall outside the scope of § 101 as failing to produce a useful, concrete and tangible result.

**1. Claim 31.**

Applicant argues that Hawkins fails to disclose "establishing a subject record, the record including the first image," "associating the at least one second image with the subject record," and "providing the subject with viewing access to the subject record".

In response to this argument it is noted that Hawkins explicitly teaches said features. Specifically, Hawkins teaches:

capturing an image of a body feature [0039], thereby indicating a step of *establishing a subject record*. It is noted that ability to compare the first captured image/record of a consumer with a second image captured later indicates comparing the second image with the image of record, or first image. Without establishing such a record, or the first image, the "comparing" step simply would not be possible.

Furthermore, Hawkins teaches:

capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer [0041], thereby indicating a step of *associating the at least one second image with the subject record*. Examiner stipulates that without a step of associating the second image with the subject record it would not be possible to conduct the "comparing" step, because nobody would know with which (second) image the first image has to be compared. Indeed, at the beauty facility, serving a plurality of customers, how would a sales representative/operator know which images, including a first one and a second, out of a plurality of images of a plurality of consumers, have to be compared if there is no established record about said consumer? And how would the sales representative/operator know which second image has to be used to compare with an existing record (first image) of a consumer if said second image is not associated with the existing consumer record (first image)? To this end Examiner maintains that the steps of "establishing a subject record, the record including the first image," and "associating the at least one second image with the subject record," are inherently disclosed in Hawkins.

As per the step of: "providing the subject with viewing access to the subject record", Hawkins teaches that said images are displayed to the consumer [0044].

## **2. Claims 32-38 and 57.**

Applicant argues that Hawkins fails to disclose "distributing at least one cosmetic product to the beauty facility," "instructing the beauty facility to capture images of the external body condition before and after application of the at least one cosmetic product," and "instructing the beauty facility to display to the customer the before and after images so that the customer may be provided with a visual indication of progress".

In response to this argument it is noted that Hawkins teaches:

selecting a cosmetic product and capturing an image of a body feature before and after application of the cosmetic product at a sales counter (beauty facility) [0039]; [0053]. Examiner point out that said "selecting" and "applying" steps conducted at the sales counter (*beauty facility*) are possible only if said cosmetic products are available and present at the beauty facility. Where did said cosmetic products come from? It is inherent that said cosmetic products had to be distributed/delivered from the place of manufacturing of said product to said beauty facility where said "selecting" and "applying" steps took place. Examiner maintains that without distributing said cosmetic products from the place of manufacturing of said products to said sales counter prior to offering said cosmetic products to the subject, there would not be any products to select from by the subject and apply to the subject at said sales counter. Therefore, the step of "distributing said cosmetic product to the point of sale", in its broadest sense, is inherently disclosed in Hawkins.

Furthermore, Hawkins teaches:

capturing an image of a body feature before and after application of the cosmetic product at a sales counter (beauty facility) [0039]; [0053]; and displaying captured and transformed images to the user [0044]. To this end Examiner points out that Hawkins teaches that the subject is assisted with said method at said sales counter

by a sales representative/operator [0035]; [0053]. Such professional assistance indicates a provision of the necessary skill and knowledge about beauty product and how to apply said beauty product including safe application technique, considering a type of skin of an individual, time of a day and time of a year (season), allergy consideration and compatibility with other cosmetic or medical product the subject may use, without mentioning the knowledge of current trend in beauty fashion. Said necessary skill and knowledge is not the type of skill an average person would have, but one that would require studying and specific training. For example, the wrong advice may trigger a serious allergy reaction or an accidental injury, causing complicated health and legal consequences. Therefore, without receiving special *instructions or training* by said operator (facility) how to conduct said method prior to said "assisting" the subject, said operator would not be able to provide said services at the professional level and to conduct said method steps. Therefore, the "instructing" step is inherently disclosed in Hawkins.

### **3. Claims 49, 60 and 61.**

Applicant argues that Hawkins fails to disclose "analyzing the first and second information to determine an extent of differences that occurred in the body condition between the first and second time frames" and "prescribing at least one beauty product based on the extent of determined differences".

In response to this argument it is noted that Hawkins teaches: capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time [0041]; digitally transforming the captured images to determine differences that occurred in a body condition [0044]; offering (prescribing) a cosmetic product based on the results [0053].

As one can see, a cosmetic product prescribed to the subject is based on determination/analysis of differences between the images captured before and after application of the cosmetic products, said images representing the body condition before and after application of the cosmetic products.

(10. 4) **Argument E. (Brief, pages 23-28)**

**1. Claims 1-4 and 53.**

Applicant argues that Hawkins and Marapane fails to disclose “enabling the subject to view ... first information, ... second information, and at least part of ... stored information”.

In response to this argument it is noted that a combination of Hawkins and Marapane et al. discloses these features. Specifically, Hawkins teaches:

after obtaining first information (capturing an image of a body feature) [0039], and obtaining second information (capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer) [0041], displaying captured and transformed images to the user [0044]. As per “stored information”, which reflects the subject’s usage of the beauty product, Marapane et al. was applied for this feature. Specifically, Marapane et al. teaches a method for recommending beauty products (hair color agents), including obtaining (facilitating storage) information regarding how often a subject has colored his/her hair over the past year (Figs. 1 and 16, item 130; page 4, lines 16-17).

In response to applicant’s argument that there is no suggestion to combine Hawkins and Marapane, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case both references relate to recommending beauty products to customers based on information obtained from the customers. The motivation to combine the references

would be to estimate subject's body (hair or skin) condition, and based on that provide a subject with another coloring, thereby provide the subject with most suitable product, as specifically stated in Marapane (page 4, lines 17-18).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Indeed, in this case, the primary reference and the secondary reference both are pertinent to the particular problem with which Applicant was concerned - recommending beauty products to customers based on information obtained from the customers.

## 2. Claims 5-24, 27-30 and 54-56.

Applicant argues that that Hawkins and Marapane fails to disclose "enabling the subject to view ... first image, ... second image, and ... stored information on a display device, to thereby visually observe changes that occurred between times when the first and second images were captured".

In response to this argument it is noted that a combination of Hawkins and Marapane et al. discloses these features. Specifically, Hawkins teaches:

after obtaining first information (capturing an image of a body feature) [0039], and obtaining second information (capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer) [0041], displaying captured and transformed images to the user [0044]. As per "stored information", which reflects the subject's usage of at least one of the beauty products, Marapane et al. was applied for this feature. Specifically, Marapane et al. teaches a

method for recommending beauty products (hair color agents), including obtaining (facilitating storage) information regarding how often a subject has colored his/her hair over the past year (Figs. 1 and 16, item 130; page 4, lines 16-17).

In response to applicant's argument that there is no suggestion to combine Hawkins and Marapane, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case both references relate to recommending beauty products to customers based on information obtained from the customers. The motivation to combine the references would be to estimate subject's body (hair or skin) condition, and based on that provide a subject with another coloring, thereby provide the subject with most suitable product, as specifically stated in Marapane (page 4, lines 17-18).

### **3. Claims 48.**

Applicant argues that Hawkins and Marapane fails to disclose "enabling the subject to view ... first image, ... second image, and ... stored information on a display device, to thereby visually observe changes that occurred between times when the first and second images were captured."

In response to this argument it is noted that a combination of Hawkins and Marapane et al. discloses these features. Specifically, Hawkins teaches:

after obtaining first information (capturing an image of a body feature) [0039], and obtaining second information (capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer) [0041], displaying (on a display device) captured and transformed images to the user [0044]. As per "stored information", which reflects the subject's usage of the beauty product,

Marapane et al. was applied for this feature. Specifically, Marapane et al. teaches a method for recommending beauty products (hair color agents), including obtaining (facilitating storage) information regarding how often a subject has colored his/her hair over the past year (Figs. 1 and 16, item 130; page 4, lines 16-17).

In response to applicant's argument that there is no suggestion to combine Hawkins and Marapane, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case both references relate to recommending beauty products to customers based on information obtained from the customers. The motivation to combine the references would be to estimate subject's body (hair or skin) condition, and based on that provide a subject with another coloring, thereby provide the subject with most suitable product, as specifically stated in Marapane (page 4, lines 17-18).

#### **4. Claims 50-52.**

Applicant argues that Hawkins and Marapane fails to disclose "providing instructions for storage of third information relating to behavior of a subject between ... first and second time frames," and "establishing a subject record, the record including ... first, second and third information, wherein the subject is enabled to maintain control of the subject record".

In response to this argument it is noted that Hawkins in view of Marapane teaches said features. Specifically, Marapane discloses storing information reflecting subject's behavior between capture of the first image and capture of the second image (taking initial color reading of the subject hair; applying a beauty product to the subject

hair (behavior step); taking a second color reading of the subject hear after said coloring step) (page 8, lines 8-10).

As per "providing instructions" per se, Examiner maintains that Hawkins teaches that the subject is assisted with said method at said sales counter by a sales representative/operator [0035]; [0053]. Such professional assistance indicates a provision of the necessary skill and knowledge about beauty product and how to apply said beauty product including safe application technique, considering a type of skin of an individual, time of a day and time of a year (season), allergy consideration and compatibility with other cosmetic or medical product the subject may use, without mentioning the knowledge of current trend in beauty fashion. Said necessary skill and knowledge is not the type of skill an average person would have, but one that would require studying and specific training. For example, the wrong advice may trigger a serious allergy reaction or an accidental injury, causing complicated health and legal consequences. Therefore, without receiving special *instructions or training* by said operator (facility) how to conduct said method prior to said "assisting" the subject, said operator would not be able to provide said services at the professional level and to conduct said method steps. Therefore, the "providing instructions" feature is disclosed in the combination of Hawkins and Marapane.

Furthermore, Hawkins teaches:

capturing an image of a body feature [0039], thereby indicating a step of *establishing a subject record*. It is noted that ability to compare the first captured image/record of a consumer with a second image captured later indicates comparing the second image with the image of record, or first image. Without establishing such a record, or the first image, the "comparing" step simply would not be possible; at the beauty facility, serving a plurality of customers, how would a sales representative/operator know which images, including a first one and a second, out of a plurality of images of a plurality of consumers, have to be compared if there is no established record about said consumer? And how would it be possible to display both images to the subject if both first and second images/information are not in the subject record? To this end Examiner maintains that the steps of "establishing a subject record, the record

including the first and second information," is disclosed in the combination of Hawkins and Marapane. As per "third information", Marapane was applied for this feature (See the discussion above).

Furthermore, Hawkins teaches that at least one "capturing" step can be conducted at the subject's home by himself over the Internet [0053], thereby indicating enabling subject to maintain control of the subject record.

In response to applicant's argument that there is no suggestion to combine Hawkins and Marapane, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case both references relate to recommending beauty products to customers based on information obtain from the customers. The motivation to combine the references would be to estimate subject's body (hair or skin) condition, and based on that provide a subject with another coloring, thereby provide the subject with most suitable product, as specifically stated in Marapane (page 4, lines 17-18).

(10. 5) **Argument F. (Brief, pages 28-34)**

1. **Claim 45.** Applicant argues that Maloney and Marapane fails to disclose "enabling the data structure to maintain a historical record of at least some of the recorded cosmetic product usage information and personal information," and "causing at least one product to be recommended to the individual, wherein the at least one product recommendation is generated using at least a portion of the historical record".

In response to this argument it is noted that Maloney teaches: providing by the consumer information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement and lifestyle (page 7, lines 1-2); obtaining feedback from the consumer (*update*) for the cosmetic products offered (page 12, lines 15-16); based on the collected and updated information recommending a cosmetic product to the consumer (page 12, lines 15-16). Marapane was applied to show that said provided by the consumer information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement includes customer cosmetic product usage (obtaining information regarding how often a subject has colored his/her hair over the past year) (Figs. 1 and 16, item 130; page 4, lines 16-17).

In response to applicant's argument that there is no suggestion to combine Hawkins and Marapane, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case both references relate to recommending beauty products to customers based on information obtain from the customers. The motivation to combine the references would be to estimate subject's body (hair or skin) condition, and based on that provide a subject with another coloring, thereby provide the subject with most suitable product, as specifically stated in Marapane (page 4, lines 17-18).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the primary reference and the secondary reference both are pertinent to the particular problem with which Applicant was concerned - recommending beauty products to customers based on information obtained from the customers.

**2. Claims 46 and 47.**

Applicant argues that Maloney and Marapane fails to disclose "causing, when ... subject's cosmetic usage is inconsistent with ... cosmetic usage of individual's with lifestyles similar to the subject's lifestyle, at least one product to be recommended to the subject".

In response to this argument it is noted that Maloney teaches:

providing a customized *cosmetic* product combination to a consumer, comprising: providing (recording) by the subject information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement and lifestyle over the Internet (page 7, lines 1-2; page 15, line 29 – page 16, line 4); comparing the recorded information with a database of the same type of information of a plurality of individuals (page 7, lines 1-2, 9-11); determining whether the information provided by the subject is consistent with the same type of information of a plurality of individuals (page 7, lines 3-11; page 9, lines 21-22); recommending a cosmetic product to the subject based on said determination (page 7, lines 13-14). Furthermore, Maloney teaches while the consumer is initially assigned to an appropriate category of consumers (consistent with the cosmetic usage and lifestyles of a trend of use of at least some of the plurality of individuals), the classifying neural network can *continuously update its decision by incorporating consumer feedback to provide a customized beauty product* to the consumer (page 9, lines 12-32; page 10, lines 8-14), thereby *suggesting* providing the customized product when subject's cosmetic usage is inconsistent with the cosmetic usage and lifestyles of a trend of use of at least some of the plurality of individuals.

In response to applicant's argument that there is no suggestion to combine Hawkins and Marapane, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case both references relate to recommending beauty products to customers based on information obtain from the customers. The motivation to combine the references would be to estimate subject's body (hair or skin) condition, and based on that provide a subject with another coloring, thereby provide the subject with most suitable product, as specifically stated in Marapane (page 4, lines 17-18).

(10. 6) **Argument G. (Brief, pages 34-37)**

**Claim 25.** Applicant's arguments applied to claim 25, that the prior art of record does not teach "enabling the subject to view the first image, the second image, and the stored information on a display device, to thereby visually observe changes that occurred between times when the first and second images were captured," essentially the same as arguments applied to claim 5. Therefore, reasoning applied to claim 5 is equally applicable to claim 25.

In response to applicant's argument that there is no suggestion to combine Hawkins, Marapane and Redbook Image, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case both Hawkins and Marapane relate to recommending beauty

products to customers based on information obtain from the customers. The motivation to combine the references would be to estimate subject's body (hair or skin) condition, and based on that provide a subject with another coloring, thereby provide the subject with most suitable product, as specifically stated in Marapane (page 4, lines 17-18).

Redbook Image was applied to show that the tangible recording media includes a *visible marking* identifying a distributor. Indeed, Redbook Image discloses an image of a CD (which appears to be released in June, 1995), containing a *visual depiction* of a manufacturer/distributor (IBM). The motivation to combine Hawkins and Marapane to include that said tangible recording media includes a *visible marking* identifying a distributor would be promoting distributor's products.

Applicant further argues that the examiner's motivation "to promote distributor's product" is "too broad and vague, and not explicit in the references."

In response to this argument, Examiner stipulates that there is nothing "too broad and vague" about promoting a product. For example, drug companies spent \$907 million in the first half of the 1999 to advertise their products, and \$1.3 billion in the same period in 2000. (2000: Top Developments on the Pharmaceutical Landscape. *The Federal Government Assumes a Greater Voice in Healthcare*; 2000; page 3). In 1991-1995, the color cosmetics market was estimated at \$4.3 Billion (Retail Dollar Value). *In 1994 alone \$234 Million spent for color cosmetic advertising including \$112 Million spent to advertise skin makeup* (Packaged Facts; Color Cosmetics Market; 11-1995; page 4). Examiner is convinced that *\$234 Million spent for color cosmetic advertising* were not spent for *vague* purposes.

In response to Applicant's argument that motivation is not explicit in the References, Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is

respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

Furthermore, the Court in *In re Fritch* stated "[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. [emphasis added]" *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596,1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). In the present case Examiner has shown that motivation for combining the references existed in the prior art. The "modification" referred to in *In re Fritch* involves extensive changes to the primary references. Such is not the case in the present combination, where all modifications proposed by the Examiner are specifically taught by the references and that knowledge generally available to one of ordinary skill in the art.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Indeed, in this case, the primary reference and the secondary reference both are pertinent to the particular problem with which Applicant was concerned - recommending beauty products to customers based on information obtained from the customers.

(10. 7) **Argument H. (Brief, page 37)**

1. **Claims 39-43 and 58.**

Applicant argues that Maloney fails to disclose "a transportable computer-readable media".

In response to this argument it is noted that while Maloney teaches: providing a subject with a image capturing device for recording and displaying personal beauty information including an image of a subject (page 20, lines 27-28; page 26, claim 20); wherein said recording and displaying indicates recording said information on a computer-readable media, wherein said recorded information could be read at beauty facilities (a central location or kiosks) and updated (page 11, line 17-18; page 15, lines 4-6), and wherein providing the subject with image capturing device at home indicates updating said personal beauty information at a location remote from the beauty facility, Maloney does not explicitly teach that said computer-readable media is a transportable computer-readable media. However, Maloney teaches the use of floppy diskettes, compact discs and laser discs as a computer-readable medium (page 13, lines 31-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said personal beauty information is recorded on a *transportable* media, because it would advantageously allow to use this method in geographical locations where network communication is not available.

In response to applicant's argument that there is no suggestion to combine Hawkins and Marapane, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case both references relate to recommending beauty products to customers based on information obtain from the customers. The motivation to combine the references would be to estimate subject's body (hair or skin) condition, and based on that provide a subject with another coloring, thereby provide the subject with most suitable product, as specifically stated in Marapane (page 4, lines 17-18).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Indeed, in this case, the primary reference and the secondary reference both are pertinent to the particular problem with which Applicant was concerned - recommending beauty products to customers based on information obtained from the customers.

## 2. Claims 44 and 59.

Applicant's arguments applied to claims 44 and 59 essentially the same as those applied to claims 39-43 and 58. Therefore, reasoning applied to claims 39-43 and 58 is equally applicable to claims 44 and 59.

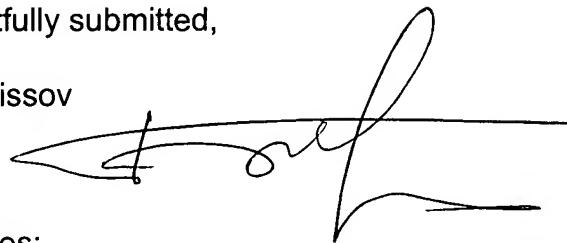
### (11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Igor Borissov



Conferees:

Vincent Millin



John W. Hayes

